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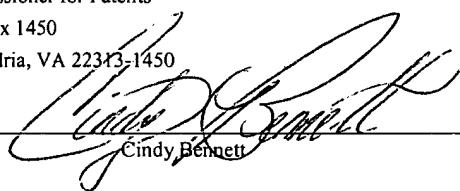
PATENT
Attorney Docket No.: 019281-000700US

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MAIL STOP: APPEAL BRIEF - PATENTS

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By:



Cindy Bennett



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

John J. Sie, et al.

Application No.: 09/687,138

Filed: October 12, 2000

For: LOCAL NEAR VIDEO
ON DEMAND STORAGE

Customer No. 20350

Confirmation No.: 1028

Examiner: Bui, Kieu Oanh T

Technology Center/Art Unit: 2611

**APPELLANT BRIEF UNDER
37 CFR §41.37**

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants offer this Brief further to the Notice of Appeal mailed on September 15, 2004 along with a two month extension of time.

1. Real Parties in Interest

Privately held Starz Entertainment Group is the real party in interest of the above-identified application. Starz Entertainment Group is controlled by Liberty Media Corporation, a publicly-traded entity.

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2. Related Appeals and Interferences

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3. Status of Claims

Claims 1 – 20 are currently pending in the application. All pending claims stand finally rejected pursuant to a Final Office Action mailed March 15, 2004. The rejections of claims 1 – 20 are believed to be improper and are the subject of this appeal.

4. Status of Amendments

An amendment was filed subsequent to the Final Office Action on September 15, 2004. This amendment was filed after the Advisory Action and was never entered by the Office. This appeal is based upon the state of the claims before the amendment of September 15, 2004.

5. Summary of Claimed Subject Matter

The invention generally relates to delivering a program using a near video on demand (NVOD) system, for example. Application, page 19, first full paragraph; Figures 9A-10B. In the embodiment of claim 1, a process for pre-storing a portion of a program distributed on a plurality of distribution conduits and in a linear schedule with staggered start times is described. Id. A first start time of the program is determined for a first distribution conduit, and a second start time of the program is determined for a second distribution conduit. Id., Fig. 9A, reference designators 928 and 932; Id., page 21, lines 21-22. A stagger time between the first start time and the second start time is also determined. Id., page 19, lines 4-5; Id., page 21, lines 23-24. A segment of the program equal in length to the stagger time is stored. Id., page 21, lines 23-24. A user request is detected to begin playing the program after the storing step has begun. Id., page 21, lines 24-25.

In the embodiment of claim 10, a distribution program product for pre-storing a portion of a program distributed on a plurality of distribution conduits and in a linear schedule

with staggered start times is disclosed. Id., page 19, first full paragraph; Figures 9A-10B. First code determines a first start time of the program on a first distribution conduit. Id., Fig. 9A, reference designators 928 and 932; Id., page 21, lines 21-22. Second code determines a second start time of the program on a second distribution conduit. Id. Third code determines determining a stagger time between the first start time and the second start time. Id., page 19, lines 4-5; Id., page 21, lines 23-24. Fourth code stores a segment of the program about equal in length to the stagger time that begins storing the segment before a user requests the program. Id., page 21, lines 23-24. A computer-readable medium for stores the first, second, third, and fourth sets of codes. Id., page 34, claim 10.

In the embodiment of claim 20, a method for pre-storing a portion of a program distributed on a plurality of distribution conduits and in a linear schedule with staggered start times is disclosed. Id., page 19, first full paragraph; Figures 9A-10B. In one step, a first start time of the program on a first distribution conduit is determined. Id., Fig. 9A, reference designators 928 and 932; Id., page 21, lines 21-22. A second start time of the program on a second distribution conduit is determined. Id. At least one of the first and second distribution conduits comprises at least one of a digital channel, an analog channel, or a broadband network. Id., page 20, lines 4-6. A stagger time between the first start time and the second start time is determined, where the determining the stagger time comprises subtracting the first start time from the second start time. Id., page 19, lines 4-5; Id., page 21, lines 23-24. A segment of the program about equal in length to the stagger time is stored, where the storing the segment comprises beginning to store the segment proximate to a user location before the user requests to view the program. Id., page 21, lines 23-24.

6. Grounds of Rejection Presented for Review

A. Claims 1-3, 5-6, 8-9 and 20 stand rejected under 35 U.S.C. §102(b) as being anticipated by cited portions of U.S. Patent No. 5,724,646 to Ganek et al. ("Ganek").

B. Claims 4, 7 and 10-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ganek in view of cited portions of U.S. Patent No. 5,589,892 to Knee et al. ("Knee").

7. Argument

A. Whether claims 1-3, 5-6, 8-9 and 20 are anticipated by Ganek

The final Office Action has rejected claims 1-3, 5-6, 8-9 and 20 under 35 U.S.C. §102(b) as being anticipated by Ganek. For a valid anticipation rejection, the Office must show that each and every limitation from the claims appears in a single piece of prior art. Applicants strongly believe that Ganek does not teach or suggest storage of video prior to a request by the user, as required by all claims.

Interviews were conducted with the Examiner on September 14, 2004, November 8, 2004 and December 16, 2004 to discuss the Ganek reference with respect to this limitation. In an interview summary mailed September 27, 2004, the Examiner indicated being persuaded that Ganek didn't anticipate these claims and that a new office action would be forthcoming. This appeal was filed because no office action appears forthcoming. A check of private PAIR on January 14, 2005 indicates that an office action has not been issued.

As understood by the Appellant, the final Office Action seems to take the position that the buffering of a program occurs before a user request in Ganek. Appellant can find no such teaching or suggestion in Ganek. Final Office Action, page 3, first paragraph, last clause. Indeed, Ganek consistently teaches that buffering occurs after the time of a user request (T_{req}). In Fig. 2d, T_{req} appears to the left in a time line to the "Buffer Store" line that indicates the start of buffering, which clearly shows the request before and initiating the buffering. On col. 2, lines 18-20, indicate that buffer storage is "responsive to the request for the video program." Ganek goes on to teach "a buffer for storing the selected in-progress transmission of the video program . . ." Ganek, col. 2, lines 52-53. In Fig. 3 of Ganek, T_{req} occurs in step 430 and is followed by step 440 where buffering begins, which shows the request before the buffering. Ganek, col. 6, line 65 through col. 7, line 9.

The claims require pre-storing a portion of the program prior to the user request for the program. As discussed above Ganek only stores the program after it is requested. In one embodiment of the claimed invention, this pre-storage allows substantially immediate playback of the program sourced from a NVOD line-up. In contrast, Ganek only teaches or suggests that the user wait a lead-in time period ($T_{lead-in}$) as a maximum delay before viewing the program. Ganek, col. 4, lines 13-24. Granted, this $T_{lead-in}$ can be substantially less than the prior art, for example, Ganek teaches that $T_{lead-in}$ could be less than a minute. Ganek, col. 8, lines 11-13. Clearly, viewers do not wish to wait for their program to become available and even a substantially reduced delay is not desired. The claimed invention innovates over Ganek in this way to allow substantially immediate playback in one embodiment.

Applicant cannot agree that Ganek teaches the claims and requests reconsideration in light of the preceding argument.

B. Whether claims 4, 7 and 10-19 being rendered obvious over Ganek in view of Knee

The final Office Action has rejected claims 4, 7 and 10-19 under 35 U.S.C. §103(a) as being unpatentable over Ganek in view of Knee. The Office is generally charged with putting forth a *prima facie* showing of obviousness. Appellants believe a *prima facie* case of obviousness has not been properly set forth in the final Office Action. The basic test is excerpted below:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in

the applicant's disclosure." MPEP §2143, Original Eighth Edition, August, 2001,
Latest Revision May 2004.

Applicants believe the rejection has flaws with all three prongs of the above test for establishing a *prima facie* case of obviousness as outlined below.

The limitation in the claims relating to pre-storage before a user request once again relies upon Ganek for teaching this limitation. The arguments in the preceding sub-section are also appropriate to show that Ganek cannot be reasonably relied upon to teach this limitation and are not repeated here.

Appellant believes the rejection based upon a combination of Ganek and Knee is improper because the motivation to combine is lacking. The final Office Action puts forth some general motive for the combination without any cite to a reference. Final Office Action, page 7, first paragraph, last sentence. Without using claim 10 as a template, it is unclear why anyone of ordinary skill in the art would make this specific combination of limitations from these two references.

Further, it is not clear that the broadband network of Knee could be combined with Ganek and have any chance of success without undue experimentation. Packet switched broadband networks are generally ill suited for broadcast transmissions such as would be used for a NVOD line-up. A multi-cast standard for broadcast over a packet switched network has been publicly proposed, but has generally failed to be widely implemented because of bandwidth saturation issues. The suggested combination would require that all networks would have to receive the transmission of each NVOD video. As sending video is bandwidth intensive, it does not logically follow that this teaching from Knee could be added to Ganek with any measure of success.

Reconsideration is respectfully requested.

8. Conclusion

Please deduct the requisite fee, pursuant to 37 C.F.R. §1.17(c), of \$500.00 from deposit account 20-1430 and any additional fees associated that may be due in association with the filing of this Brief.

Appl. No. 09/687,138
Appeal Brief dated January 14, 2005

PATENT

If for any reason the Office believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Office is invited to telephone the undersigned attorney at (303) 571-4000.

Respectfully submitted,

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APPENDIX

The claims pending in the application are as follows:

1. (Previously Presented) A method for pre-storing a portion of a program distributed on a plurality of distribution conduits and in a linear schedule with staggered start times, the method comprising:
determining a first start time of the program on a first distribution conduit;
determining a second start time of the program on a second distribution conduit;
determining a stagger time between the first start time and the second start time;
storing a segment of the program about equal in length to the stagger time; and
detecting a user request to begin playing the program after the storing step has begun.
2. (Original) The method for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 1, wherein at least one of the first and second distribution conduits comprises at least one of a digital channel and an analog channel.
3. (Original) The method for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 1, wherein at least a portion of the first and second distribution conduits share a same channel.
4. (Original) The method for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 1, wherein at least one of the first and second distribution conduits comprises a broadband network connection.
5. (Original) The method for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start

times as recited in claim 1, wherein the determining the stagger time comprises subtracting the first start time from the second start time.

6. (Original) The method for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 1, wherein the storing the segment comprises storing the segment at a user location.

7. (Original) The method for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 1, wherein the storing the segment comprises storing the segment in a non-volatile manner.

8. (Original) The method for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 1, wherein the storing the segment comprises storing the segment on a rotating disk.

9. (Original) The method for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 1, further comprising recording the segment from the first distribution conduit.

10. (Previously Presented) A distribution program product for pre-storing a portion of a program distributed on a plurality of distribution conduits and in a linear schedule with staggered start times, the distribution program product comprising:

code for determining a first start time of the program on a first distribution conduit;

code for determining a second start time of the program on a second distribution conduit;

code for determining a stagger time between the first start time and the second start time;

code for storing a segment of the program about equal in length to the stagger time that begins storing the segment before a user requests the program; and
a computer-readable medium for storing the codes.

11. (Original) The distribution program product for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 10, wherein at least one of the first and second distribution conduits comprises at least one of a digital channel and an analog channel.

12. (Original) The distribution program product for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 10, wherein at least a portion of the first and second distribution conduits share a same channel.

13. (Original) The distribution program product for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 10, wherein at least a portion of the first and second distribution conduits share a same transponder.

14. (Original) The distribution program product for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 10, wherein at least one of the first and second distribution conduits comprises a broadband network connection.

15. (Original) The distribution program product for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 10, wherein the code for determining the stagger time comprises code for subtracting the first start time from the second start time.

16. (Original) The distribution program product for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 10, wherein the code for storing the segment comprises code for storing the segment at a user location.

17. (Original) The distribution program product for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 10, wherein the code for storing the segment comprises code for storing the segment on a rotating disk.

18. (Original) The distribution program product for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 10, further comprising code for recording the segment from the first distribution conduit.

19. (Original) The distribution program product for pre-storing the portion of the program distributed on the plurality of distribution conduits and in the linear schedule with staggered start times as recited in claim 10, wherein the code for storing the segment comprises code for storing the segment in a non-volatile manner.

20. (Previously Presented) A method for pre-storing a portion of a program distributed on a plurality of distribution conduits and in a linear schedule with staggered start times, the method comprising:

determining a first start time of the program on a first distribution conduit;

determining a second start time of the program on a second distribution conduit, wherein at least one of the first and second distribution conduits comprises at least one of a digital channel, an analog channel, a broadband network;

determining a stagger time between the first start time and the second start time, wherein the determining the stagger time comprises subtracting the first start time from the second start time; and

storing a segment of the program about equal in length to the stagger time, wherein the storing the segment comprises beginning to store the segment proximate to a user location before the user requests to view the program.